



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,430	09/21/2000	Delphine Gabrielle Josette Rca	4205.1US	6289

7590 03/22/2002
Allen C Turner
Trask Britt & Rossa
P O Box 2550
Salt Lake City, UT 84110

EXAMINER

EWOLDT, GERALD R

ART UNIT	PAPER NUMBER
----------	--------------

1644

DATE MAILED: 03/22/2002

W

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/666,430

Applicant(s)
Rea et al.

Examiner
G.R. Ewoldt

Art Unit
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 23, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-15, 17-19, and 28-36 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1, 4-15, 17-19, and 28-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

1. The location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Dr. Gerald Ewoldt, Art Unit 1644, Technology Center 1600.

2. Applicant's amendment and response, filed 10/23/01, is acknowledged. Upon reconsideration, however, the previous restriction requirement and election are vacated. A new restriction follows. The Examiner apologizes for any inconvenience or delay.

3. The substitute specification filed 10/23/01 has not been entered because it does not conform to 37 CFR 1.125(b) because: the statement as to a lack of new matter under 37 CFR 1.125(b) is missing.

4. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1, 5-7, 9-15, and 28-29, drawn to a method of preparing a pharmaceutical composition for reducing an unwanted T cell response comprising culturing dendritic cells and activating them through a CD40 receptor, classified in Class 435, subclasses 375 and 377.

II. Claims 4, 30-32, and 34-36, drawn to a method of reducing an unwanted T cell response in a host comprising culturing said T cells with dendritic cells activated through a CD40 receptor, classified in Class 424, subclass 93.71, and Class 435, subclass 347.

III. Claims 1 and 8, drawn to a method of preparing a pharmaceutical composition for reducing an unwanted T cell response comprising culturing dendritic cells and activating them through infection with a recombinant virus, classified in Class 435, subclasses 377 and 455.

IV. Claims 17-19, drawn to a method for functionally modifying a T cell *in vitro*, classified in Class 435, subclass 347.

V. Claims 4 and 33, drawn to a method of reducing an unwanted T cell response in a host comprising culturing said T cells with dendritic cells activated through infection with a recombinant

virus, classified in Class 424, subclass 93.71, and Class 435, subclasses 347 and 455.

5. Inventions I-V are different methods. Said methods comprise different reagents, e.g., Inventions II, IV, and V include T cells whereas Inventions I and III do not; Inventions III and V include recombinant viruses whereas Inventions I, II, and IV do not. Said methods further comprise *in vitro* (Invention IV) versus *in vivo* (Inventions II and V) method steps. Therefore the methods are patentably distinct.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Should Applicant elect Group I, II, or IV, Applicant is further required under 35 U.S.C. § 121 to elect a **specific** activating substance, such as one of those listed in Claims 6 or 7,

and list all Claims readable thereon including those subsequently added. Currently Claims 1, 4-5, 9-15, 17-19, 28-30, and 34-36 are generic.

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The different activating substances comprise significantly different chemical properties, e.g., protein ligands versus lipopolysaccharides, and biological properties, e.g., protein receptor ligands versus antibodies. Therefore, the species are independent and patentable over one another.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least

one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.



G.R. Ewoldt, Ph.D.
Patent Examiner
Technology Center 1600
March 21, 2002